



IFW A/E 3712 \$
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: MICHAEL GREENBERG
SERIAL NO.: 10/092,896

FILED: March 8, 2002

FOR: INFANT MOBILE HAVING MULTIPLE
ACTIVATION MODES, INCLUDING A KICK-BAR
ACTIVATION MODE AND A REMOTE
ACTIVATION MODE

GROUP ART UNIT: 3712

EXAMINER: A. Adelwahed

ATTY. REFERENCE: GREE3008/BEU

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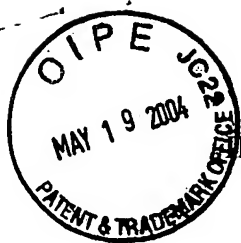
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of)	Atty. Ref.: GREE3008/beu
)	
Michael GREENBERG)	Group Art Unit: 3712
)	
Serial Number: 10/092,896)	Examiner: A. Adelwahed
)	
Filed: March 8, 2002)	Confirmation No. 2716

For: Infant Mobile Having Multiple Activation Modes, Including A Kick-Bar Activation Mode And A Remote Activation Mode

APPELLANT'S BRIEF UNDER 37 C.F.R. §1.192

Sir:

This paper is an Appeal Brief in furtherance of the Notice of Appeal filed in this case on April 1, 2004. The fee required under 37 C.F.R. §1.17(f) accompanies this Appeal Brief.

This Brief contains these items under the following headings and in the order set forth below:

- I. Real Party In Interest**
- II. Related Appeals And Interferences**
- III. Status of Claims**
- IV. Status of Amendments**
- V. Summary of Invention**
- VI. Issues**
- VII. Grouping of Claims**
- VIII. Arguments**
- IX. Conclusion**
- X. Appendix of Claims Involved in the Appeal**

I. Real Party In Interest

The real party in interest is Shelcore, Inc., 347 Elizabeth Avenue, Somerset, NJ 08873.

II. Related Appeals And Interferences

There are no related appeals or interferences.

III. Status of Claims

The status of the claims in this application is:

A. Status of all the claims

1. Claims canceled: None
2. Claims withdrawn from consideration: None
3. Claims pending: 1-17
4. Claims allowed: None
5. Claims objected to: None
6. Claims rejected: 1-17

B. Claims on Appeal:

The claims on appeal are: 1-17

IV. Status of Amendments

An Amendment and Response under 37 CFR §1.116 was submitted on February 18, 2004. The amendments included in the Amendment and Response have been entered and are reflected in the attached listing of claims.

V. Summary of the Invention

The claimed invention involves the following three main features:

- an infant mobile (elements 4, 12, 13, 16, 17 *et al.*) that may be remotely activated by a transmitter in response to kicking of a “kickbar” or “kick plate” 3 so that when the infant kicks the kickbar, the mobile is turned on;

- the principle of using a kickbar (3) to activate a switch (51) and transmitter (52), resulting in a remote control that can be activated by an infant that is not yet able to crawl or manipulated objects; and
- an infant-activated remote that can, in turn, be remotely turned on or off by a parent using a second remote control (38).

Like all inventions, the present invention is a combination of known elements, including a kick-bar (3) that activates a switch (51), and a mobile that can be remotely activated by a wireless transmitter (52). **The invention is to connect the wireless transmitter (52) to the switch (51) in the kick-bar unit, thereby enabling an infant to activate the wireless transmitter.** As explained in the introductory portion of the specification, kickbars are currently used to enable an infant to activate devices directly connected to the kickbar, such as spinners, lights, or music generators. However, the invention adds a transmitter to the kickbar so that the kickbar can be used as an infant-activated remote control, enabling the infant to turn-on a remotely located device that has no apparent connection to the kickbar.

Claim 1 recites two basic elements of the invention, namely the mobile unit and a kicking unit, *“the kicking unit including a kick-bar arranged to be moved when kicked by an infant, said kick-bar activating a switch which causes a wireless transmitter to send said wireless command signal to said mobile unit, whereby said kicking unit serves as a first remote control unit for activating said mobile.”* The claims dependent from claim 1 recite various features of the kick-bar and a second, parent operated remote control, as follows: Claim 2 recites the feature where the kicking unit may optionally include a speaker and lights, while claims 3-7 recite the feature of a second remote control that can made use of the receiver in the mobile to enable remote activation (claim 3) or shut-off (claim 4) of the mobile by the infant’s parents, and to enable the kick-bar to activate the mobile (claim 5).

Claim 8 is an independent claim directed to the broader principle of the invention, which is to provide an infant-activated remote control device, by arranging the kick-bar to activate a

switch, which in turn activates a transmitter so that the kick-bar operates as a remote control. Dependent claims 9-13 respectively recite that the device operated by the remote control is a mobile, and the lights/music and second remote control.

Finally, claim 14 is an independent claim directed to the third aspect of the invention, namely the combination of the infant-activated remote and a second parent-operated remote, with receivers being included not only in a mobile but also in the kicking unit so that the second remote control can be used to activate the first transmitter and enable a parent operating the second remote control to remotely turn-on or off the remote activation feature of the kick-bar. Dependent claims 15-17 are respectively directed to features of the transmitters, and the inclusion of speakers and lights in the kicking unit.

VI. Issues

The sole issue involved in this Appeal is whether the subject matter of claims 1-17 is rendered obvious under 35 USC §103(a) by the subject matter disclosed in U.S. Patent Nos. 6,203,395 (McElhaney) and 6,113,455 (Whelan), and the Publication Entitled “*Kick Start Bush Crib Center*” (the Kick Start Publication).

VII. Grouping of the Claims

Appellants most respectfully submit that claims each of the claims should be judged individually, except that claims 2 and 10 may be grouped together with respective claims 1 and 8, from which claims 2 and 10 respectively depend.

VIII. Arguments

It is respectfully submitted that the rejection of claims 1, 2, 8, and 10, which recite the combination of an infant activated kick-bar and a wireless transmitter, should be reversed because:

- (i) even though kick-bars and wireless transmitters are known, none of the references of record suggests the claim combination of a kickbar, switch, and wireless transmitter activated by the switch in the kickbar unit so that an infant can remotely activate devices by kicking the kickbar, thereby effectively providing an infant-activated remote control that gives even a pre-mobile infant, *i.e.*, an infant that cannot purposely move around, the ability to “operate” a remote device such as a crib mobile;
- (ii) the Examiner’s sole justification for combining the kick-bar and wireless transmitter, namely that the combination of the devices disclosed in the McElhaney and Whalen patents, and the Kick Start publication, “improve(s) the entertainment value of the crib toy,” is clearly a hindsight justification since none of the references suggests that adding a wireless transmitter to a kickbar, much less that such an addition will improve the entertainment value of the kickbar. The prior art wireless transmitter is provided solely for the convenience of the parents, and not to improve the entertainment value of the toy.

It is true that the McElhaney patent teaches a kickbar, which gives non-mobile infants to generate lights and sounds associated with the kicking unit, and to activate a rotating bar in the same unit. This is an improvement over prior crib toys that could only be activated by infants capable of purposely grabbing objects using their hands (infants can kick long before they can use their hands). However, there is not the slightest suggestion in this reference of including a wireless transmitter to further increase the entertainment (and educational/developmental) value of the kicking unit.

According to the Examiner, one reason that the addition of a wireless transmitter to the kicking unit of McElhaney would have been obvious is that substitution of wireless remotes for wired remotes are known in the toy art. This conclusion is not logical. Just because it is known to substitute a wireless remote for a wired remote in the context, for example, of a flying model airplane, does not mean that such a substitution would have been obvious in the context of crib

toys. First, McElhaney does not actually teach a wired remote, much less a wireless one. Second the activity center of McElhaney is an integral unit, and there is no possible need for a wired or wireless remote. If the McElhaney patent is viewed without the benefit of Applicant's disclosure, it can be seen that none of the objectives of the patent would in any way be furthered by the addition of a wireless transmitter. The rotating bar disclosed therein can be rotated without a wireless transmitter, and the addition of a wireless transmitter would not improve the operation of the device or increase its entertainment value, *unless* one considers the possibility of using the kickbar to operate a device that is in fact separate from the kicking unit, such as a crib mobile (which typically must be placed out of reach of the infant to prevent strangulation). McElhaney clearly does not consider or suggest, explicitly or implicitly, such as a possibility, and neither do any of the other references of record or the recognized equivalence, in some toy related contexts, of wired and wireless remotes.

The one reference that teaches any sort of remote control of a crib mobile, or other crib toy, is the Whalen patent. However, this is what Whalen actually teaches concerning remote control of a mobile (col. 6, lines 9-15:

...It should be noted that the portable module also includes a music button, a light button, a mobile button, and a timer button similar to those set forth hereinabove. Further, a power button and a radio channel/band selector may be included, as shown in FIG. 2. The control panel is preferably equipped with a receiver in order to allow remote control of the various features of the frame by these buttons.

Nowhere in this passage, or any other passage in the Whalen patent, is there a teaching that the transmitter should or could be moved from a portable module operable by a parent to the crib in which the mobile is situated, much less in a way that permits the baby to remotely activate the mobile. The purpose of the transmitter is very clearly to permit a parent to activate the mobile. **Neither Whalen nor McElhaney even remotely suggests that the entertainment value of a mobile would be increased if the baby, rather than just the parent, could remotely activate it.**

Furthermore, Whalen does not, as suggested by the Examiner, teach a "second" transmitter for operating a mobile, as recited in claim 14. The "first" transmitter in Whalen has an entirely

different function than the “second” transmitter, namely to transmit signals from a microphone 44 situated on the cross bar of the mobile to the portable module so that the baby’s sounds can be monitored. This cannot reasonably be said to be suggestive of providing two transmitters to activate a mobile, as claimed. The second transmitter of Whalen is on the mobile itself, and transmits signals to the remote control—not the other way around. This is a specific teaching of Whalen and the ordinary artisan would not simply have ignored it, as the Examiner has done, for the purpose of justifying the addition of a wireless transmitter and second remote to the kicking unit of McElhaney, which includes neither a wireless transmitter nor a second remote capable of turning the wireless transmitter on and/or off.

The sole motivation for the combination continues to be that the combination improves “the entertainment value of the crib toy.” The motivation is not based on any advantages of the toys disclosed in the references, or on any suggestion or teaching of combining those toys in a way that would result in the advantage, but rather on the advantages of the combination that is taught only in Applicant’s own specification.

It may very well be obvious *in hindsight* that a kickbar activated mobile provides increased entertainment value (as well as increased “educational” value since it teaches the baby about cause and effect). However, the McElhaney patent certainly does not disclose or suggest that adding a transmitter to the kickbar would add to its entertainment value (to the contrary, if McElhaney had suggested that adding a transmitter would add to the entertainment value of the electronic activity center, it is likely that some ordinary artisan would have been motivated to do so). Similarly, the Whalen patent does not disclose or suggest that adding a transmitter to a kick bar would add to its entertainment value (the transmitter of Whalen does not add to the entertainment value of the mobile, but merely enables a parent to turn it on and off from across the room, for the convenience of the parent), and the Kick Start publication not only does not disclose or suggest that adding a transmitter to a kick bar would add to its entertainment value, but fails to disclose any sort of transmitter or kick bar. Therefore, the motivation of increasing entertainment value could only have come from the teachings of the Applicant, adopted in hindsight by the Examiner. Without that hindsight, the

ordinary artisan motivated by the teachings of McElhaney, Whalen, and Kick Start to add a transmitter to the kickbar of McElhaney so as to permit the baby, as opposed to its parents, to activate a mobile. The fact that adding the transmitter turns out to be a good idea is not an indication that the addition would have been obvious.

Using the advantages of a combination to justify a rejection is classic hindsight. Under this “reasoning,” all combinations are obvious if they have advantages. Only non-advantageous combinations can possibly be patentable. Even though a combination is not disclosed or suggested in the references, and the advantages of the combination are not possessed by any of the devices being combined, the combination is, according to the Examiner, obvious solely because the prior devices *could* be combined, and because the *combination* has advantages.

Under the Examiner’s reasoning, for example, Edison’s patent on a tungsten filament light bulb would have been obvious solely because the combination of known materials (tungsten) and concepts (running electricity through a filament) resulted in the advantage of improved light output for an extended period. Of course, the Edison’s light bulb clearly was not obvious, *despite its advantages*, because no one had thought to combine a light bulb with a tungsten filament. Similarly, Morse’s telegraph would have been considered obvious under the present Examiner’s reasoning because wires and electrical signals *could* have been combined to send dots and dashes, and because the *combination* has the advantage of permitting remote communications.

The rejection of the present invention uses exactly the same reasoning. Because one *could* place a parent-activated transmitter into a kickbar, and even though no reference suggests doing so, because the result of the combination is to “improve the entertainment value of the crib toy,” the combination must be obvious. Moreover, any suggestions to the contrary in the references themselves are simply dismissed by the Examiner on the grounds that the references were not cited for their contrary teachings.

The Examiner is of course correct that motivation for the combination must be expressly articulated. However, the motivation must nevertheless come from the references and not be made in hindsight. Furthermore, the motivation must be the result of what is actually taught by the references, and not by selective “interpretation” or templating in a way that would not have occurred to the ordinary artisan in the absence of the Applicant’s own teachings concerning the combination. No one of ordinary skill in the art would have interpreted the electronic activity center of McElhaney in the manner suggested by the Examiner, *i.e.*, as a “wired” remote equivalent to a wireless remote in the manner suggested by the Official Notice.

The actual teachings of the prior art, properly considered without hindsight “interpretation” and selection of teaching for the purpose of “merely to teach” certain concepts recited in the claims (see the second and third paragraphs on page 4 of the final Office Action), may be summarized as follows:

	McElhaney	Whalen	Kick Start	Claimed
Kick-Bar	Yes, but no remote, wireless <i>or</i> wired	No	No	Yes, activates remote
Transmitter in Kickbar	No	Transmitter for parents—nothing to do with kick bar and <u>no</u> suggestion that combination with a kickbar would improve entertainment value	No	Yes, so that baby can remotely activate mobile

Logically, if three references do not disclose or suggest adding a transmitter to a kickbar, the three references also could not possibly have suggested the *advantages* of doing so. This has nothing to do with whether the teachings are express or implied, as alleged by the Examiner. **None** of the references teaches or suggests, *whether expressly or by implication*, modification of the entertainment center of McElhaney to include a kick bar activated remote control for activating a

mobile, and **none** suggests any sort of baby-activated remote control. Yes, the result of the combination is improved entertainment value for the baby, but this is an advantage of the *combination*, and not a teaching or suggestion of any of the references. The fact that a combination has advantages not recognized in the prior art is logically an indication of non-obviousness rather than obviousness.

The reason that the claimed combination is more entertaining is that the combination that any of the prior art baby toys is that it gives the infant control over the activation of a remotely located device. The McElhaney patent does not give an infant remote control over the activation of a remotely located device, but only allows a baby to directly activate a crib toy. The applicant is not claiming direct activation of a crib toy by a kick bar. Furthermore, the Whelan patent does not give the infant control over a remotely located device, but rather gives parents control. The Kick Start publication does not include any sort of remote control.

It is of course well-known to provide different types of devices with remote controls that can be operated by non-infants. However, none of the references of record discloses or suggests any sort of remote control device, and particularly one for a crib mobile, that can be operated by infants. From the infant's point of view, the ability to remotely activate objects is a major advance, never before accomplished or even suggested in the history of baby toys. Yes, this is an advantage, but the fact that it is advantageous is not, as alleged by the Examiner, an indication of obviousness. The claimed combination, suggested only by the Inventor, gives infants powers that go way beyond the power provided by the kick-bar of McElhaney, since it permits the infant to operate a device that is unconnected, from the infant's point-of-view, to the kick-bar. The parent-operated remote control of Whelan of course gives no such power to the infant. **No toy, in the history of baby toys, has ever given an immobile infant the power of remote control, i.e., the power to activate a mobile situated above the infant's crib *without the assistance of parents*.** Remote controls have been known for a long time, as have crib mobiles, and their combination is known from the Whelan patent. But Whelan does not suggest the further step provided by the invention, namely making the remote control accessible to an immobile baby. Only Applicant's specification suggests doing so.

In summary, it is respectfully submitted that in order for a combination to be proper, there must be some express or implied reason for the combination,¹ and that any such express or implied reason for the combination depends on what is actually taught in the references, *i.e.*, on the teachings of the references as a whole.² Since the references of record in the present application fail to provide any such express or implied reason for the claimed combination of a kickbar, switch, *and* transmitter, as recited in claims 1 and 8, much less the addition of features recited in the remaining claims such as a second remote control for turning the first remote control (kick-bar activated transmitter) on and off, the rejection of claims 1-17 under 35 USC §103(a) is improper.

¹ See, for example, *In re Fritch*, 23 USPQ2d 1780,1783 (Fed. Cir. 1992), which points out that 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so [quoting *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 221 USPQ 929,933 (Fed. Cir. 1984)].' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

See, also, *In re Gorman*, 18 USPQ 2d 1886, 1888 (Fed. Cir. 1990), which states that it is improper to ...simply to engage in a hindsight reconstruction of the claim invention, using the applicant's structure as a template and selecting elements from references to fill the gaps [citing *Interconnect Planning Corporation v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985)].

² As stated in MPEP 2143.02:

*If the proposed modification or combination of the prior art would **change the principle of operation of the prior art invention being modified**, then the teachings of the references are not sufficient to render the claims prima facie obvious (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)...The court reversed the rejection holding the "suggested combination of references would require a **substantial reconstruction and redesign** of the elements shown in [the primary reference] as well as a **change in the basic principle under which the [primary reference] construction was designed to operate**" 123 USPQ at 352. (See also, MPEP 2141.02, p. 2100-107 "A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention (emphasis in the original).*

IX. Conclusion

For all of the foregoing reasons, Appellants respectfully submit that the Examiner's final rejections of claims 1-17 under 35 U.S.C. §103(a) are improper and should be reversed by this Honorable Board.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to read 'B. Urcia', with a long horizontal line extending to the right.

By: BENJAMIN E. URCIA
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X.**APPENDIX OF CLAIMS**

1. A mobile for infants, comprising:
a mobile unit including a motor, a rotating member from which are suspended a plurality of objects, and a receiver, wherein said motor is arranged to rotate said rotating member upon receipt of a wireless command signal by said receiver;
a kicking unit including a kick-bar arranged to be moved when kicked by an infant, said kick-bar activating a switch which causes a wireless transmitter to send said wireless command signal to said mobile unit, whereby said kicking unit serves as a first remote control unit for activating said mobile.
2. A mobile as claimed in claim 1, wherein said kicking unit further includes a speaker and lights.
3. A mobile unit as claimed in claim 2, further comprising a second remote control unit including a button and a wireless transmitter, said second remote control unit being arranged, when said button is activated, to also send said wireless command signal to said receiver and cause said rotating member to rotate.
4. A mobile unit as claimed in claim 2, further comprising a second remote control unit for deactivating said kicking unit.
5. A mobile unit as claimed in claim 3, wherein said remote control unit further includes a second switch, wherein said button causes said mobile unit to play continuously and said mobile unit to turn continuously, and wherein said second switch causes said mobile unit and kicking unit to initially activated and then enter a standby state in which said mobile unit is activated by said kick-bar.

6. A mobile unit as claimed in claim 1, further comprising a second remote control unit including a button and a wireless transmitter, said second remote control unit being arranged, when said button is activated, to also send said wireless command signal to said receiver and cause said rotating member to rotate.
7. A mobile unit as claimed in claim 1, wherein said wireless transmitter is an infrared transmitter.
8. An infant-activated wireless remote control, comprising:
 - a housing;
 - a kick-bar mounted in said housing;
 - a switch arranged to be activated by said kick-bar; and
 - a wireless transmitter arranged to be activated by said switch.
9. An infant-activated wireless remote control as claimed in claim 8, wherein said wireless transmitter is arranged to activate a remotely situated mobile.
10. An infant-activated wireless remote control as claimed in claim 8, further comprising a speaker and lights mounted in said housing.
11. An infant-activated wireless remote control as claimed in claim 8, further comprising a receiver situated in said housing for receiving wireless signals from a second remote control in order to deactivate said wireless transmitter.
12. An infant-activated wireless remote control as claimed in claim 11, further comprising a speaker and lights mounted in said housing, and wherein said second remote control is arranged to selectively activate a mode in which said speaker and lights are activated by said kick-bar, and a mode in which said speaker, said lights, and said transmitter are all activated by said kick-bar.

13. An infant-activated wireless remote control as claimed in claim 8, wherein said transmitter is an infrared transmitter.
14. An infant mobile, comprising:
 - a kicking unit containing a kick-bar, a first transmitter, and a first receiver,
 - a mobile unit including a second receiver, and
 - a remote control unit including a second transmitter,wherein the first transmitter communicates with the second receiver to activate said mobile unit, and wherein the second transmitter communicates with said first receiver to activate said kicking unit.
15. An infant mobile as claimed in claim 14, wherein said first and second transmitters are infrared transmitters.
16. An infant mobile as claimed in claim 14, wherein said second transmitter activates and deactivates said first transmitter.
17. An infant mobile as claimed in claim 14, further comprising a speaker and lights mounted in said kicking unit, and wherein said remote control unit is arranged to selectively activate a mode in which said speaker and lights are activated by said kick-bar, and a mode in which said speaker, said lights, and said first transmitter are all activated by said kick-bar.